

respect to novelty and inventive step. Further, under Markush practice, all alternatives must have a common property AND (i) common structure must be present in all alternatives or (ii) all alternatives must belong to a recognized class of chemical compounds. See PCT Rule 13.1 and 13.2; see also MPEP 1850.

Here, the technical relationship among the claimed inventions is the common use of the compound of formula II-1. However, compounds of formula II-1 are known in the prior art for their pesticidal properties, as acknowledged by Applicant in the instant specification page 12, line 25 to page 13, line 1. Consequently, the same or corresponding feature in all of the inventions does not define a contribution which each of the inventions makes over the prior art.

Regarding the various first active ingredients, it must be noted that there is no common structure and all alternatives do not belong to a recognized class of chemical compounds.

Therefore, the inventions are not so linked as to form a single general inventive concept; and the inventions lack unity of invention.

Moreover, to search and examine more than one invention group would place an undue burden on the Examiner. Each of the invention groups are separately classified and thus must be separately searched. Group I is classified in, inter alia, class 514, subclass 462; Group II is classified in, inter alia, class 514, subclasses 30; Group III is classified in, inter alia, class 514, subclass 587; Group IV is classified in, inter alia, class 514, subclass 28; Group V is classified in, inter alia, class 514, subclass 431. Not only is there a separate search in the patents database for each of the inventions, there is also a divergent non-patent literature search necessary for each of the invention groups due to the distinct chemical structures of the components. In the absence of a nexus type teaching, a prior art reference for one invention may not be applicable to the other inventions. In sum, under the facts of this application, the additional search and examination necessary for additional invention(s), which lack unity of invention, would rise to the level of undue burden.

(Office Action, pages 3-5). Applicants respectfully disagree, and direct attention

to section 1850 of the Manual for Patenting Examining Procedure, which states:

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of narrow, literal, or academic approach. . . . For determining the action to be taken

by the examiner . . . rigid rules cannot be given and each case should be considered on its merits, *the benefit of any doubt being given to the applicant.* (emphasis added)

MPEP § 1850 (II)(paragraph 4). The claims of the instant application do not qualify as a "clear case" of lacking unity of invention. Each claim shares the special technical feature of a formula (II-1) compound in combination with another insecticide, thus constituting "a contribution over the prior art" within the meaning of the PCT Unity of Invention Rules 13.1 and 13.2.

Applicants also disagree that there would be an undue burden on the Examiner to search all inventions together. Section 803 of the Manual for Patenting Examining Procedure states as one of the criteria for a proper requirement for restriction that "[t]here would be a serious burden on the examiner if restriction is not required . . ." Thus, the Office encourages the search and examination of an entire application on the merits, where such search and examination can be made *without* serious burden.

Applicants respectfully assert that the search of alleged Groups I-V does not impose a serious burden upon the Examiner. The Examiner has admitted that all Groups may be searched within class 514. Thus, a search concerning the patentability of the invention of Group II will likely uncover art of interest to the claims of Groups I, III, IV, and V.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is believed that extensions of time are not required, beyond those that may otherwise be provided for in accompanying documents. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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